



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/872,353 | 06/01/2001 | Brian R. McCarthy | 310048-550 | 3630 |

7590 01/12/2006

Douglas N Larson Esq
Squire Sanders & Dempsey LLP
801 S Figueroa St 14th Floor
Los Angeles, CA 90017-5554

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,353

Applicant(s)

MCCARTHY ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005 and 22 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 166-168, 207-209, 224-259 and 263-313 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 166-168, 207-209, 224-259 and 263-313 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/15/05, 8/11/05, 4/27/05, 5/24/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 166-168, 207-209, 224-259 and 263-313 are pending in the application, claims 1-165, 169-206, 210-223 and 260-262 have been cancelled.
2. Amendments to the claims, filed on October 21, 2005, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The objections to the claims, made of record in the office action mailed February 22, 2005, pages 2-3, paragraph #5 have been withdrawn due to Applicant's amendment in the response filed October 21, 2005.
4. The 35 U.S.C. §112-1st and 2nd paragraph rejections of, made of record in the office action mailed February 22, 2005, paragraphs #6 and #8 have been withdrawn due to Applicant's amendment in the response filed October 21, 2005.
5. The 35 U.S.C. §102 and 103 rejections, made of record in the office action mailed February 22, 2005, pages 4-22, paragraphs #9-14 has been withdrawn due to Applicant's amendment in the response filed October 21, 2005.

REJECTIONS

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

7. Claim 250 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 250 contain(s) the limitations “butt-cut columns” and “butt-cut rows.” The specification does not mention “butt-cut” and therefore these limitations are considered new matter. It is further noted that the examiner has previously made this rejection in the office action mailed January 15, 2004 and in the following response filed April 19, 2004 Applicant canceled this subject matter. Therefore, Applicant has already conceded that this is new matter.

The new matter must be deleted.

Claim Rejections - 35 USC § 102

8. Claims 166, 207, 224, 227-232, 234, 236-241, 244-248, 250, 252, 253, 256, 257, 259, 265, 270, 271 and 272-313 are rejected under 35 U.S.C. 102(b) as being anticipated by Doll et al. (U.S. Patent No. 4,833,122).

Doll discloses a sheet of printable business cards (*business product/labels, col. 1, lines 11-13*) comprising a card stock sheet construction (*face sheet, col. 4, line 27*) and a solid continuous liner sheet (*continuous web of backing material, col. 4, lines 30-31*) releasably secured with ultraremovable adhesive (*releasable adhesive, col. 4, line 34*) to and covering the backside of the cardstock sheet construction (*co. 4, lines 26-34 and figures 1-4*). A primer coat is between the ultraremovable adhesive and the liner sheet (*col. 8, line 5 and figure 9*).

The cardstock sheet construction has a front side and a back side and comprises continuous through-cut lines (*die cuts, col. 6, lines 32-34 and figures 1 and 2*) through the cardstock sheet construction to the back side but not through-cut through the liner sheet (*figures 1 and 2*). The through-cut lines defining at least in part perimeter edges of printable labels and of a matrix waste portion (*col. 6, lines 32-34 and figures 1 and 2*).

Portions of the back side of the cardstock sheet construction are deemed to form back side surfaces of the printable business card.

The liner sheet has areas covering the back sides of all of the through-cut lines (*figure 1*). The areas are deemed to be adapted to hold the printable business cards and the matrix waste portion together when the sheet of printable business cards is sheet fed through a printer or copier for the printing operation on the printable business cards.

The ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*figures 3-9*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are deemed to be adapted to allow the business cards to be removed from the liner sheet and from the matrix waste portion after the printing operation into the individual printed business cards.

The back side surface of the printed business cards are tack-free after removal from the liner sheet (*col. 1, lines 26-31 and col. 8, lines 9-13*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are deemed to be adapted to allow the business cards to be removed from the liner sheet and from the matrix waste portion after the printing operation into the individual printed business cards with the

Art Unit: 1772

ultraremovable adhesive remaining on the carrier sheet and not on the back side surfaces of the printed business cards (*col. 8, lines 3-13*).

The cardstock sheet construction is deemed to have a cardstock end edge, and the liner sheet is deemed to have a corresponding liner sheet end edge. Furthermore, the liner sheet end edge extends a distance out from the liner sheet edge and is deemed to form a thin end of the printable business card, since the reference discloses that the printing paper may be smaller than the support sheet (*col. 6, lines 26-34*).

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, paragraph 2 and pages 4-5, paragraph 10*). Doll’s label is deemed to meet this limitation because Doll’s label is also the cut out portion of the printing paper, i.e. label.

Doll discloses that the ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*figures 3-9*).

Doll discloses that the carrier sheet is a solid continuous carrier (*col. 4, lines 30-31*).

Doll discloses that the carrier sheet extends the entire width of the cardstock sheet construction (*figures 1-2*).

Doll discloses that adjacent ones of the printable business cards directly abut one another and share common edges (*figure 1*).

Art Unit: 1772

Doll discloses that the printable business cards are arranged in a matrix on the cardstock sheet construction (*figure 1*).

Doll discloses that (a) the cardstock sheet construction included left and right side edges and first and second edges, (b) the through-cut lines include frame cut lines and grid cut lines, (c) the frame cut lines include first and second side cut lines spaced in from the left and right side edges, respectively, and disposed parallel thereto, (d) the frame cut lines include first and second end cut lines spaced in from and parallel to the first and second end edges, both of the end cut lines engaging both of the side cut lines, (e) the frame cut lines define a central area on the facestock sheet construction, (f) the grid cut lines define a grid disposed in the central area, and (g) the grid cut lines and the frame cut lines separate the central area into the printable business cards (*figure 1*).

Doll discloses that at least some of the through-cut lines define the matrix waste portion around the printable business cards (*figures 1 and 2*).

Doll discloses the through-cut lines include vertical and horizontal cut lines (*figures 1 and 2*).

Doll discloses that the top one of the horizontal cut lines extends a full width of the cardstock sheet construction (*figure 1*).

Doll discloses that the ends of the rest of the horizontal cut lines are spaced inwardly from the left and right side edges of the facestock sheet construction (*figures 1 and 2*).

Doll discloses the rest of the horizontal cut lines extend a distance out beyond the outermost of the vertical cut lines (*figure 1*).

Doll discloses that the carrier sheet comprises a base paper sheet (*col. 4, lines 42-43*).

Art Unit: 1772

Doll discloses that the carrier sheet covers the entire back side of the cardstock sheet construction (*figure 1*).

Doll discloses that the through-cut lines define all of the perimeter edges of all of the printable business cards (*figures 1 and 2*).

Doll discloses that the printable business cards are arranged in a two column matrix on the cardstock sheet construction (*figure 1*).

Doll discloses that the printable business cards in each column of the two column matrix abut adjacent printable business cards in the same column separated only by respective ones of the through-cut lines (*figure 1*).

Doll discloses that the printable business cards comprise a matrix block of printable business cards completely surrounded by the matrix waste portion (*figure 1*).

Doll discloses that the printable business cards are arranged in a plurality of butt-cut columns and a plurality of butt-cut rows (*figure 1*).

Doll discloses that the cardstock sheet construction and carrier sheet are both rectangular and have the same width and length dimensions (*figure 1*).

the cardstock sheet construction is deemed to have a cardstock end edge, and the carrier sheet is deemed to have a corresponding carrier end edge, which is deemed to be ½ inch wide.

Doll discloses that the back side surface of the printed business cards are tack-free after removal from the carrier sheet (*col. 1, lines 26-31 and col. 8, lines 9-13*).

Doll discloses that a cut line in the carrier sheet extends across at least substantially an entire width of the carrier sheet (*figure 1*).

Art Unit: 1772

the cut line is deemed to define a printer inflected flexibility cut line of the printable business card sheet construction, since it can be seen from the figures that the cut lines are near the edges of the assembly.

Doll discloses that the cardstock sheet construction includes a cardstock sheet and the ultraremovable adhesive is directly on the cardstock sheet (*figures 4-9*).

Doll discloses that the cardstock sheet construction includes a cardstock sheet and the ultraremovable adhesive is directly on the cardstock sheet (*figures 4-9*).

The ultraremovable adhesive is deemed to provide partial contact with the cardstock sheet construction (*col. 1, lines 26-31 and col. 8, lines 9-13*).

Doll discloses that the sheet of printable business cards has A4 dimensions.

Doll discloses that the printable business cards are arranged in a plurality of rows and a plurality of columns (*figure 1*).

Claim Rejections - 35 USC § 103

9. Claims 167, 168, 208, 209, 225 and 226 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doll in view of Hollis et al. (U.S. Patent No. 5,622,758).

Doll is relied upon as described above.

Doll fails to disclose that the liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet or that the narrow exposed strip is approximately ½ inch wide.

Hollis discloses a label sheet comprising a backing sheet and one or more labels affixed to the backing with adhesive (*col. 5, line 62 through col. 6, line 20*). The backing sheet has a

Art Unit: 1772

leading edge and a trailing edge that extends out to form a narrow exposed strip extending the entire width of the liner sheet (*col. 5, line 67 through col. 6, line 1 and figures 3 and 4*). The label sheet is easily loaded into machinery (*col. 4, lines 49-51*).

Doll and Hollis are analogous because they discuss printable tags/labels.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have Doll's liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet as taught by Hollis in order to make the sheet material easy to load into machinery.

The exact size of the narrow exposed strip of the liner sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as size of the narrow exposed strip, through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

10. Claims 251, 258, 263, 266 and 267 rejected under 35 U.S.C. 103(a) as being unpatentable over Doll as applied above.

Doll is relied upon as described above.

Doll further discloses that the printable business card sheet (*label system, page 3, line 18*) has dimensions in conformity with conventional paper standards (*page 3, lines 28-29*).

Doll fails to disclose that the printable business card sheet construction is 8.5 x 11 inches.

However, the Examiner takes Official Notice that a sheet construction having dimensions of 8.5 x 11 inches is a conventional paper standard for printers, especially desktop or home computer printers, in the United States. MPEP § 2144.03.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a card sheet construction with dimension of 8.5 x 11 inches as the conventional paper standard paper size in Doll in order to conform to US home computer printers. One of ordinary skill in the art would have been motivated to a sheet with dimensions of 8.5 x 11 inches in order to increase sales in the US to consumers with person computers.

Doll also fails to disclose that the cut line is approximately $\frac{1}{4}$ inch from an end edge of the carrier sheet.

The exact distance of the cut line to the carrier sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Doll also fails to disclose that the cardstock sheet construction is approximately 9.0 mils.

The exact thickness of the cardstock sheet construction is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed thickness. *In re Boesch*, 205 USPQ 215

Art Unit: 1772

(CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

11. Claims 233, 249, 268 and 269 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doll in view of Carlson (U.S. Patent No. 5,842,722).

Doll is relied upon as described above.

Doll fails to disclose that the cardstock sheet construction is coated/glossy.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (*col. 1, lines 16-18*). The printable laminate includes die cut cards, which are coated with an ink receptive coating (*col. 19, line 50 through col. 20, line 3*). The ink receptive coating provides good ink image retention and adhesive retention (*col. 20, lines 1-3*).

Doll and Carlson are analogous because they discuss printable tags/labels.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the tag of Doll in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (*col. 20, lines 1-3*). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

Doll discloses that the carrier sheet comprises a base paper sheet.

Art Unit: 1772

12. Claims 235, 242 and 243 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doll in view of Cross (U.S. Patent No. 4,863,772).

Doll is relied upon as described above.

Doll fails to disclose that the carrier sheet is densified bleached kraft paper or the thickness of the carrier sheet.

Cross discloses label stock comprising a facestock paper, a pressure-sensitive adhesive, a layer of low density polyethylene (film), and densified bleached kraft paper release layer with a thickness of 3.1 mil (*figure 5 and col. 5, lines 1-38*).

Doll and Cross are analogous because they both discuss label/tag constructions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Cross' densified bleached kraft paper as the liner sheet of Doll, since it would have been within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, unless densified bleached kraft paper gives unexpected results. *In re Leshin*, 125 USPQ 416.

The exact thickness of the carrier sheet is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

Art Unit: 1772

13. Claims 254, 255, 260, 261 and 264 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doll in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Doll is relied upon as described above.

Doll fails to disclose that the an edge of the sheet is thinner than a body of the sheet or that the sheet is calendered.

Examiner's comment: The limitation "the printable business card sheet is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the printable business card sheet is calendered," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Doll and Hickenbotham are analogous because they all discuss label/tag constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of Doll as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51.

It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

ANSWERS TO APPLICANT'S ARGUMENTS

14. Applicant's arguments in the response filed June 22, 2005 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ac

1/9/06



**ALICIA CHEVALIER
PRIMARY EXAMINER**